

#### IV. AMENDMENTS TO THE DRAWINGS

- THE DRAWINGS OF THE PATENT IS HEREBY AMENDED AS SET FORTH BELOW:

- There are no amendments to the drawings.

## V. REMARKS/ARGUMENTS

- STATUS OF THE CLAIMS

Claims 40, 41, 45, 47-55 were pending during the issuance of the Office Action. Claims 40, 41, 45 and 47 are currently canceled. Claim 48, 50-55 are currently amended. No new matter was added.

- REJECTION UNDER 35 U.S.C. §103

Examiner's Stance

Claims 40, 41, 45, 47-53 and 54 are rejected under 35 USC 103(a) as obvious over previously cited Ravkin (US 6,169,816) in view of Tisone (US 2004/0072364), further in view of Rutenberg (US 5,287,272) and even further in view of Atwood (US 5,681,741)

In the Examiner's opinion, the claimed automatic microscope system comprising a dispensing reagents, a thermocycler and a transporter is *prima facie* obvious over the combined references.

Concerning Claim 48, Examiner alleges (last line of page 4 and first line page 5 of the Office Action) that Ravkin "further teaches that the microscopic system is computerized (column 5, line 66-67 to column 7, lines 1-5) ... compris[ing] processors that are linked with any number of peripheral devices (column 6, lines 1-7)." Examiner alleges on page 4 line 12 (and pages 7 last line and page 10 line 2) of the office action that Ravkin "...specifically teaches interfacing a computer to external instruments (column 5, line 22-25)." In this reference, the Examiner points out that Tisone specifically uses an EPROM to facilitate the interfacing systems such as that of Ravkin and therefore deeming that the instant claims would be obvious. Finally, the Examiner alleges that the transporter and thermocycler of the instant claims would also be *prima facie* obvious in view of Rutenberg and Atwood.

Applicant's Response

Applicant respectfully but strongly disagrees. Applicant continues to assert that the automatic nature of the instant invention, both disclosed and claimed, represents a distinct difference and unique advantage over cited references Ravkin and Tisone, as well as Rutenberg and Atwood, taken singly or combined.

Applicants respectfully traverse the rejections of claims 48 through 55 under 35 U.S.C. §103(a).

The Applicant asserts that the Examiner cited prior art references do not provide sufficient grounds for establishment of a *prima facie* case of obviousness, as set forth in Graham v. John Deere Co., 383 U.S. 1, 148 USPQ 459 (1966), summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or non-obviousness.

The Applicant further calls the Examiner's attention to MPEP 2143.03, which states that to establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art.

With respect to the currently amended instant claim 48, the limitations require, in part:

(ii) *automatically recording coordinates of said cell candidate, or said blob comprising said labeled rare cell, in the optical field;*

(iii) *automatically locating said reagent dispenser over said cell candidate, or cell blob comprising said cell candidate, based on said position coordinates; and*

*(iv) automatically dispensing reagent from said reagent dispenser onto said cell candidate, or said blob comprising said cell candidate.*

Claim 48 claims, in part, a method of candidate cell location and further evaluation by means of contact with reagents provided by means of a system-guided dispenser.

This is patently distinct from Ravkin who discloses a microscope system but is completely silent on a reagent dispenser to treat specific locations on a slide. Concerning external instruments in general, Ravkin teaches (Col 5, line 22):

“The particular techniques for interfacing a computer to external instruments are known to those skilled in the art...”

The cited steps of the instant claim are also patently distinct from Tissone. Tissone unlike Ravkin discloses a dispenser but is silent on teachings or disclosure of a means to enable interfacing with a microscopy system such as in the instant claim. Relevant to this, in a section specifically entitled ‘Alternative configurations’ [0118], Tissone discloses the following:

"one or more EPROMs could store the computer code. Each EPROM could connect to one or more microprocessors each of which would connect to one or more drivers to provide the appropriate signal to each electromechanical device”

Tissone specifies that the *EPROMs could store computer code*. EPROMs require the application of ultraviolet light, obtained from an external erasing source, to erase the memory contents. This mode of erasure is not consistent with the instant claim requiring *recording the position coordinates of said labeled cell, or said blob comprising said labeled cell in an optical field*, [Instant claim 1] wherein location data is stored and erased automatically on a slide by slide basis. In addition, Tissone teaches that the *EPROMs could store the computer code*. The definition of computer code is: *the symbolic arrangement of statements or instructions in a computer program in which letters, digits, etc. are represented as binary numbers; the set of instructions in such a program* [Random House Dictionary; 2009]. In contrast, the instant claims specify the recording of the position coordinates, which is differentiable from computer code.

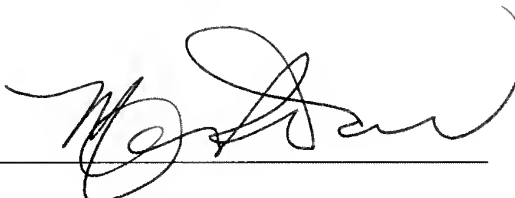
The combination of Ravkin and Tissone, do not anticipate the instant claims. Such combination, would, at least, require that Tissone's EPROMs change their principle of operation so that slide by slide data storage and erasure be automatically performed on a slide by slide basis and further that computer code be stored, rather than location data. In accordance with MPEP 2143.01 [VI], if the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious.

Applicant, therefore, requests reconsideration and withdrawal of the rejection of independent claim 48 and dependent claims 49 through 55.

#### CONCLUSION OF REMARKS

Applicant assert that this response is a good faith effort to place the application in condition for allowance. Applicant respectfully seek early allowance of the pending claims.

Respectfully submitted,



Date: May 28, 2009

Marvin R. Wachs,  
Reg. No.: 58,227  
KELLEY DRYE & WARREN LLP  
400 Atlantic Street  
Stamford, CT 06901  
Phone 203-351-8072  
Fax: 203-327-2669  
E-mail: mwachs@kelleydrye.com

## **VI. APPENDIX**

- *No appendix is intended to be attached*